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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,856	10/08/2003	Chiaming Chai	BUR9-1999-0287-US2	7132

30449 7590 07/28/2004

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EXAMINER	
CHAUDRY, MUJTABA M	

ART UNIT	PAPER NUMBER
2133	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/681,856	CHAI ET AL.
	Examiner	**Art Unit**
	Mujtaba K Chaudry	2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 October 2003*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7,8,11-15 and 17-20* is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4,7,8,11-15 and 17-20* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *08 October 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10//8/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

This application appears to be a division of Application No. 09669117, filed September 25, 2000. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application. The Examiner acknowledges the divisional status of the present application under 37 CFR 1.35(b), as alluded by the Applicants. Furthermore, cancellation of claims 5-6, 9-10 and 16 is acknowledged in the preliminary amendment submitted October 08, 2003 and subsequently claims 1-4, 7-8, 11-15 and 17-20 are currently pending in the present application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7-8, 11-15 and 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6658610 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the 6658610B1 reference are essentially an embodiment of the claims in the present application. For example, reference 6658610B1 teaches in claim 1 a memory array comprising a compilable address magnitude comparator, the compilable address magnitude comparator receiving a self-test address from a self-test controller and comparing the self-test address to a compiled maximum address of the memory array, the compilable address magnitude comparator preventing testing of memory of the memory array corresponding to the self-test address if the self-test address exceeds the compiled maximum address, wherein the compilable address magnitude comparator prevents testing of memory of the memory array **by forcing a memory pass signal.** [Emphasis added]. Claim 1 of the present application teaches a memory array comprising a compilable address magnitude comparator, the compilable address magnitude comparator receiving a self-test address from a self-test controller and comparing the self-test address to a compiled maximum address of the memory array, the compilable address magnitude comparator preventing testing of memory of the memory array corresponding to the self-test address if the self-test address exceeds the compiled maximum address. Claim 1 of the present application is a broader version of claim 1 in 6658610B1 reference, since claim 1 of the present application does not teach explicitly how compilable address magnitude comparator prevents testing of the memory of the memory array corresponding to the self-test address if the self-test address exceeds the compiled maximum address. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a broader claim from a narrower claim as is done this instance. The Examiner would like to point out that even though the conflicting claims are not exactly identical, they are not patentably distinct from each other because the claims in the 6658610B1 reference are essentially an embodiment of the claims in the present application.

Drawings

The drawings are objected to because:

- The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **In Figure 1, reference number 108 is not listed in the specification**. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per

37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

- The drawings are objected to under 37 CFR 1.83(a) because they **fail to show reference number 402 in Figure 4 as described in the specification**. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

- The drawings are objected to under 37 CFR 1.83(a) because they **fail to show reference number 502 in Figure 5 as described in the specification**. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

Specification

The disclosure is objected to because of the following informalities:

- Applicant is reminded of the proper language and format for an abstract of the disclosure.

  The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

  The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

  The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the **first paragraph of 35 U.S.C. 112**:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 7-8, 11-15 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- For example, throughout the specification (i.e. page 3, line 9) the Applicants used the term "...**BIST controller compiled** to test memory..." The Examiner would like to emphasize that the term "compiled" or compile is usually referred to when a computer program/code is translated into machine language so that the computer may understand it. The usage of the term "compile" (or compiling compliable etc.) is incorrect throughout the specification. Although the Applicants are entitled to be their own lexicographers, a term may not be used repugnant to the normal definition. Furthermore, the term "compile" is used incorrectly in the claims, for example, in claim 1: "...a compilable address magnitude comparator..." It is not clear how a address magnitude comparator could be compilable, since it is a device and not a computer program/code. The Application is replete with the incorrect usage of the term "compile" and all its forms. The Applicants' assistance is sought to address this issue in all instances throughout the specification and claims.

Appropriate correction is required.

The following is a quotation of the **second paragraph of 35 U.S.C. 112**:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 4, 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims state, **"...wherein the compilable address magnitude comparator prevents testing of memory of the memory array by forcing a read operation instead of a write operation."** The Examiner would like to point out that there is no positive limitation stated. The claim merely states what compilable magnitude comparator does and not what it comprises/interacts. The functionality is not considered to be a positive limitation. Applicants are suggested to either cancel such claims or provide amendment which includes positive limitation(s). Furthermore, the Examiner would like to point out that similar language is noted in other claims (i.e. independent claims 1, 12 and 17). However, this language is not given any patentable weight for the reasons stated above. As previously mentioned, the language "...wherein the compilable address magnitude comparator prevents testing of memory of the memory array by forcing a read operation instead of a write operation" within the claims only states the outcome/effect which is not considered to be a positive limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 7-8, 11-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (USPN 5535164).

As per claims 1, 7, 12 and 17, Adams et al. (herein after: Adams) substantially teaches (title and abstract) a single BIST which can test various memories of different sizes, types and characteristics by using a state machine to select and generate all patterns required for testing all of the memories on the chip, and impressing all of the data, including expected data, and address information on all of the memories simultaneously. The BIST also generates unique (separate) control signals for the various memories and impresses these control signals on the various memories. The BIST selectively asserts the various control signals so as to apply (write) the data and to read and capture (load result) failure information only to/from those memories whose unique controls are asserted. Selective assertion of a memory's write enable signal prevents multiple writes to a location which can potentially mask cell write and leakage defects while selective assertion of a memory's load result signal is performed only when valid memory output data is expected so as not to capture false error information. The control signals instruct those memories that do not use a particular sequence of inputs or any portion of a given sequence of inputs to "ignore" such signals, thereby generating the necessary signals to form the test patterns for each and every memory, the data and address information for those patterns, the control signals to write and read each memory, and capture error information for that particular memory. A single BIST can be used to test a multiplicity of memories of different sizes and different types. Selective assertion of a memory's write enable signal prevents multiple writes to a location which can potentially mask cell write defects and cell leakage defects. Selective assertion of a memory's load result signal prevents capture of a false fail signal due to potentially inverted data stored in the memory in the second and subsequent address accesses. Adams teaches (col. 3, lines 20-56) the BIST circuit 10 shuts off each memory's WE and LR signals as the current address exceeds that memory's address space and whenever else appropriate according to the individual memory's function. Shutting off the WE prevents rewriting memory locations through a particular pattern. Rewriting a memory can potentially mask charge leakage problems in the cells. When the maximum address is reached, the state machine enters a WAIT state, resets the address counter, and performs various updates, including the assertion of a new subcycle. Furthermore, Adams teaches (col. 4, line 57—col. 5, lines 1-16) a content addressable memory (CAM) 24. The memory 24 is a 512 X 10 bit memory, with the 512 entries broken up into groups of eight 10-bit comparators. A content addressable memory (CAM) is one in which binary data written therein is stored at the various address locations, but in this embodiment said stored data cannot be directly read out. The Cam memory performs the function of comparing binary data asserted thereon to determine if it has a particular bit pattern stored therein. If a pattern is so stored, the CAM memory responds by outputting an appropriate output signal, e.g., a binary "1", and if the pattern is not stored, a binary "0", on the output of each comparator depending on the data stored. Expressed another way, the CAM memory 24 acts as a comparator in which bits are stored in pre-selected patterns which correspond to portions of an address for another memory, and when a bit pattern is impressed on the CAM 24, the CAM 24 compares the impressed bit pattern with the stored bit patterns to determine if the particular bit pattern is stored, and which one of eight comparators found the bit pattern. Thus, the test function of the CAM requires an inputting of various test data and then performing a compare function between data stored therein and binary test data impressed thereon and determining if the output response is appropriate to indicate such a stored data being present at a given location or not.

Adams does not explicitly teach the address comparator to be a "compilable address magnitude comparator" as stated in the present application.

However, the specification on the present application teaches (specification, pages 1-4), in part, the compilable magnitude comparator address comparator overrides the self-test from the BIST when the BIST attempts to test addresses that do not exist in the memory. The Examiner would like to point that Adams teaches, as previously stated, a single BIST which can test various memories of different sizes, types and characteristics, wherein the BIST shuts off each memory's WE and LR signals as the current address exceeds that memory's address space and whenever else appropriate according to the individual memory's function. Shutting off the WE prevents rewriting memory locations through a particular pattern. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Adams by incorporating a "compilable address magnitude comparator" within the method and apparatus. This modification would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art would have recognized that by making the address magnitude compilable would enable it to efficiently override the self-test from the BIST when the BIST attempts to test addresses that do not exist in the memory.

As per claims 2, 3, 13 and 14, Adams substantially teaches, in view of above rejections, (cols. 11-13) comparing the rows and columns against maximum thresholds. The Examiner would like to point out the functionality if the row and column comparator is inherently included since both rows and columns are compared.

As per claims 4, 8 and 15, Adams substantially teaches, in view of above rejections, a single BIST which can test various memories of different sizes, types and characteristics, wherein the BIST shuts off each memory's WE and LR signals as the current address exceeds that memory's address space and whenever else appropriate according to the individual memory's function. Shutting off the WE prevents rewriting memory locations through a particular pattern.

As per claims 11, Adams substantially teaches, in view of above rejections, (col. 16, line 50—col. 17, lines 1-3) a single built-in self-test device for testing a plurality of memories, at least two of which have different characteristics and require different test patterns, comprising: logic to generate test data in pre-selected test patterns specific to each type of memory and anticipated output compare data corresponding to said test data, logic to convey said test data to at least two of said memories simultaneously, logic to supply the address of the locations of said memory to be tested with said test data; logic to receive output data from said memory location and compare said output data with said anticipated output compare data to provide a comparison; control logic including; write enable logic to selectively cause a write function of said test data on each said memory at each addressable location thereon to be tested; and logic to selectively load the results of said comparison at each addressable location thereon to be tested.

As per claims 18-20, Adams substantially teaches, in view of above rejections, a single BIST which can test various memories of different sizes, types and characteristics by using a state machine to select and generate all patterns required for testing all of the memories on the chip, and impressing all of the data, including expected data, and address information on all of the memories. The BIST selectively asserts the various control signals so as to apply (write) the data and to read and capture (load result) failure information only to/from those memories whose unique controls are asserted. Selective assertion of a memory's write enable signal prevents multiple writes to a location which can potentially mask cell write and leakage defects while selective assertion of a memory's load result signal is performed only when valid memory output data is expected so as not to capture false error information. The control signals instruct those memories that do not use a particular sequence of inputs or any portion of a given sequence of inputs to "ignore" such signals, thereby generating the necessary signals to form the test patterns for each and every memory, the data and address information for those patterns, the control signals to write and read each memory, and capture error information for that particular memory. A single BIST can be used to test a multiplicity of memories of different sizes and different types. Selective assertion of a memory's write enable signal prevents multiple writes to a location which can potentially mask cell write defects and cell leakage defects. Selective assertion of a memory's load result signal prevents capture of a false fail signal due to potentially inverted data stored in the memory in the second and subsequent address accesses.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adams teaches a single BIST which can test various memories of different sizes, types and characteristics by using a state machine to select and generate all patterns required for testing all of the memories on the chip, and impressing all of the data, including expected data, and address information on all of the memories. Applicants are invited to read/review additional pertinent prior art that has been cited herein.

Any inquiries concerning this communication should be directed to the examiner, Mujtaba Chaudry who may be reached at 703-305-7755. The examiner may normally be reached Mon – Thur 7:30 am to 4:30 pm and every other Fri 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Albert DeCady at 703-305-9595. The fax phone number for the organization where this application is assigned is 703-746-7239.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist at 703-305-3900.

Mujtaba Chaudry
Art Unit 2133
July 16, 2004

Guy J Lamarre
Primary Examiner